

Notice of Allowability

Application No.

09/926,346

Examiner

Andrea D Small

Applicant(s)

SUGAWARA ET AL.

Art Unit

1626

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☐ This communication is responsive to _____.
2. ☒ The allowed claim(s) is/are 26-34, renumbered 1-9.
3. ☒ The drawings filed on 17 October 2001 are accepted by the Examiner.
4. ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) ☒ All b) ☐ Some* c) ☐ None of the:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).
 - * Certified copies not received: _____.
5. ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
 - (a) ☐ The translation of the foreign language provisional application has been received.
6. ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application. **THIS THREE-MONTH PERIOD IS NOT EXTENDABLE**

7. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
8. ☐ CORRECTED DRAWINGS must be submitted.
 - (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
 - 1) ☐ hereto or 2) ☐ to Paper No. _____.
 - (b) ☐ including changes required by the proposed drawing correction filed _____, which has been approved by the Examiner.
 - (c) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No. _____.

Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet.

9. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

- | | |
|---|---|
| 1 <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 2 <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3 <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 4 <input checked="" type="checkbox"/> Interview Summary (PTO-413), Paper No. <u>8/6</u> . |
| 5 <input checked="" type="checkbox"/> Information Disclosure Statements (PTO-1449), Paper No. <u>1017</u> . | 6 <input checked="" type="checkbox"/> Examiner's Amendment/Comment |
| 7 <input type="checkbox"/> Examiner's Comment Regarding Requirement for Deposit of Biological Material | 8 <input checked="" type="checkbox"/> Examiner's Statement of Reasons for Allowance |
| | 9 <input type="checkbox"/> Other |

DETAILED ACTION

I. Preliminary Matters:

- (a) Claims 1-68 are pending.
- (b) Amendment filed 7/14/2003 has been received and the election of group VI with traverse, claims 26-34 is acknowledged. Claims 1-25 and 35-68 are withdrawn from consideration as being drawn to non-elected subject matter. 37 CFR 1.142(b).
- (c) In an interview with Applicants representative, Mr. Adrian, the traversal of the restriction requirement was withdrawn in view of the indication of allowability of claims 26-34. The restriction outlined in office action of 4/14/2003 is proper. Applicants argued that because the compound claims in group XI are those employed in the process of invention of group VI and that groups I and III are methods of making those compounds, that these groups are sufficiently related so that they should be examined together. The Examiner respectfully disagrees with this assertion as the requirement for restriction is based the PCT rules that state that the technical features that can be taken as a whole should provide a contribution over the art, thereby resulting in a special technical feature that provides unity of invention between the claims. Instantly, however, the moieties that can be considered the technical features that can be taken as a whole between all the groups is $\text{-NH}_2\text{-CH}_2\text{-CO}_2\text{H}$, which was known in the art prior to the filing of the instant application, therefore, does not provide a contribution over the art and thus there is no unity of invention between the inventions. Therefore, the restriction as provided is proper and maintained.

II. Examiner's Amendment:

An examiner's amendment canceling the non-elected subject matter, i.e, claims 1-25 and 35-68 is attached to the instant office action. Permission for canceling these claims has been provided by Mr. Adrian on August 7, 2003.

III. Reasons for Allowance:

Applicant's claims relate to process of preparing optically active amino acids of formula (6). The closest prior art of record, Dauban, et al and Church, et al, teach closely related processes to that instantly claimed. The prior art, alone or in combination, however, does not teach or suggest the process of preparing N-Nosyl substituted amino acid by the reacting a N-nosyl substituted aziridine 2-acid with an organometallic reagent. Therefore, claims 26-34, renumbered 1-9 are allowed.

IV. Contact Information:

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Andrea D. Small, whose telephone number is (703) 305-0811. The examiner can normally be reached on Monday-Thursday from 8:30 AM - 7:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Joseph K. McKane, can be reached at (703) 308-4537. The Unofficial fax phone number for this Group is (703) 308-7921. The Official fax phone numbers for this Group are (703) 308-4556 or 305-3592.

When filing a FAX in Technology Center 1600, please indicate in the Header (upper right) "Official" for papers that are to be entered into the file, and "Unofficial" for draft documents and other communications with the PTO that are not for entry into the file of the application. This will expedite processing of your papers.

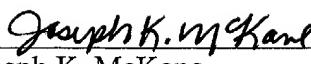
Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [Joseph.McKane@uspto.gov]. All Internet e-mail communications will be made of record in the application file. PTO employees will not communicate with applicant via Internet e-mail where sensitive data will be exchanged or where there exists a possibility that sensitive data could be identified unless there is of record an express waiver of the confidentiality requirements under 35 U.S.C. 122 by the applicant. See the Interim Internet Usage Policy published by the Patent and Trademark Office Official Gazette on February 25, 1997 at 1195 OG 89.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist, whose telephone number is (703) 308-1234

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Andrea D. Small, Esq.
August 7, 2003



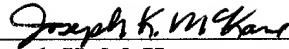
Joseph K. McKane
Supervisory Patent Examiner
Art Unit 1626
Technology Center 1

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EXAMINER'S AMENDMENT

Cancel claim 1-25 and 35-68.



Joseph K. McKane
Supervisory Patent Examiner
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Technology Center 1